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PRE-APPEAL BRIEF REQUEST FOR REVIEW

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on _____

Signature _____

Typed or printed name _____

Application Number

10/747929

Filed

12/30/2003

First Named Inventor

COOLMAN

Art Unit

3625

Examiner

Misiaszek

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record.Registration number 37955 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

BAO TRAN

Typed or printed name

408-528-7490

Telephone number

9/22/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Coolman
Application No.: 10/747,929
Filed: 12/30/2003
For: SYSTEMS AND METHODS FOR
ORDERING FROM MULTIPLE
VENDORS

Examiner: Misiaszek, Michael
Technology Center/Art Unit: 3625

PRE-APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 1, 2, 11 and 12 were rejected under 35 U.S.C. § 103(a) over Byrne and McLauchlin. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Here, Byrne does not disclose in full a system to support an electronic market place with a communication network to communicate purchase requests; one or more buyers coupled to the network to issue a purchase order specifying items from two or more suppliers; and a server coupled to the network to receive the purchase order, the server accessing a Central Contract Registry (CCR) for supplier data and generating sub-orders from the purchase order and sending the sub-orders to the two or more suppliers for fulfillment and paying the suppliers based on CCR data. Further, neither Byrne nor McLauchlin singly or in combination teaches or suggests a system to support an electronic market place with a communication network to communicate purchase requests; one or more buyers coupled to the network to issue a purchase order specifying items from two or more suppliers; and a server coupled to the network to receive the

purchase order, the server accessing a Central Contract Registry (CCR) for supplier data and generating sub-orders from the purchase order and sending the sub-orders to the two or more suppliers for fulfillment and paying the suppliers based on CCR data.

Combining Byrne with McLaughlin would not result in the claimed system. McLaughlin's objective is to provide for a system that allows internal government systems (e.g., program systems including customer relationship management, internal operations, and administrative systems including finance, procurement, property, asset sales, and grants) and external government systems (e.g., FedBizOpps, CCR, FPDS or the Federal Acquisition Management Information System) to communicate and exchange messages and allows an end user to access the plurality of disparate legacy, current, and emerging government application systems from a point of entry web-based portal in a computer communications network. Thus, the combined system would allow the purchasing agent to post solicitation information to FedBizOpps to solicit bids or to access past performance systems such as the NIH past performance system or may view detailed vendor data, which may be stored in a CCR system or to check that funds are available in the budget for the purchase and to obligate money for the ensuing payment or to report order data to FPDS or to track the newly purchased item as a fixed asset in a property management system.

The combination fails to teach using CCR data as part of the sub-order processing and payment. Hence, there is no teaching or suggestion to modify Byrne to arrive at the invention as claimed. There is no reasonable expectation of success since the needs of viewing data from various sources differ from the needs of ordering and paying multiple vendors using CCR data. Byrne and McLaughlin take mutually exclusive paths and reaches different solutions to a different problem than the claimed invention. Here, it would be necessary to make modifications not taught in the prior art in order to modify the prior art in the manner suggested since McLaughlin teaches human viewing of CCR data and not automated processing using CCR data to order and to pay vendors. As McLaughlin teaches away from the invention, it would not be obvious to modify Byrne to arrive at the invention as claimed.

The revidence shows that the reference used to reject the claims teaches away from the claimed invention since the proposed combination would render the construction of the references impracticable for their intended purposes and the combination would be uneconomical and unreliable. This teaching away is a per se

demonstration of lack of *prima facie* obviousness. The teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction. *In re Fine*, 873 F.2d 1021 (Fed. Cir. 1988).

The evidence also noted that the combination of references proposed in the Office Action would render the construction of the references impracticable for their intended purposes. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, there is no motivation to combine.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The evidence also indicates that there was no reasonable expectation of success when combining the references. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (Claims directed to a method for the commercial scale production of polyesters in the presence of a solvent at superatmospheric pressure were rejected as obvious over a reference which taught the claimed method at atmospheric pressure in view of a reference which taught the claimed process except for the presence of a solvent. The court reversed, finding there was no reasonable expectation that a process combining the prior art steps could be successfully scaled up in view of unchallenged evidence showing that the prior art processes individually could not be

commercially scaled up successfully.). *See also Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 USPQ2d 1016, 1022-23 (Fed. Cir.), cert. denied, 502 U.S. 856 (1991) (In the context of a biotechnology case, testimony supported the conclusion that the references did not show that there was a reasonable expectation of success.); *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).

As Byrne or McLauchlin, singly or in combination, does not teach or suggest all the claim limitations in the independent claims, they also fail as to each dependent claim. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Byrne, there is an inference that it came from Applicants' disclosure. Thus, Byrne and McLauchlin cannot render obvious this independent claim and those claims dependent therefrom.

In addition, each dependent claim is patentable over the cited art. Claims 3-5 and 13-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12, and further in view of King. As to claim 3, King's claim 13 for "downloading the catalog database to a Customer/Requestor computer system; modifying said catalog database to create a private catalog, said private catalog containing data different than said downloaded catalog database;" does not show the instant claim 3's keeping a local copy of the CCR database in a system database. As to claim 4, the King private catalog does not correspond to the instant claim 4's importing the CCR data into a public data storage and a private data storage. Here, in one implementation discussed on pages 16-17 of the Specification, the "CCR public data and private data are retrieved from the system database 360. The public data is used to determine the vendor's business name and mailing address (400). The private data is used to determine the vendor's EFT information such as Routing Number and Account number, among others (402). The contact information and bank information (vcndor payment information) is provided to an accounting system (in this embodiment a Costpoint system) through an interface 410." Hence, public and private information are not duplicates of each other. In contrast, King's private database is a modification of the public database. As to claim 5, it is allowable as it depends from allowable claim 1. The

corresponding claims are also allowable. Withdrawal of the rejection of these dependent claims is requested.

Claims 6-8 and 16-18 were rejected under 35 U.S.C. 103(a) as unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12, and further in view of Gieselmann. Gieselmann discloses steps for the initial registration of the company by one of its employees. In step 63 the registration control program 6 prompts the user to input company specific data and an unique company ID. For example the VAT-Number of the company i can be utilized as a unique identifier or the DUNS-Number of the company. The DUNS (a unique number assigned by Dun & Bradstreet Corp.) number can be validated using Dun & Bradstreet Corp. Modulus Ten Check Digit algorithm for the ninth digit. However, Gieselmann's DUNS numbers do not correspond to the claimed CCR as the CCR contains information not available in DUNS and thus the combination is inappropriate. Withdrawal of the rejection of these dependent claims is requested.

Claims 10 and 20 were rejected under 35 U.S.C. 103(a) as unpatentable over Byrne in view of McLauchlin and Gieselmann as applied to claims 6 and 16, and further in view of King and Mascavage. However, the references do not show the specific elements and their relationship of means for retrieving CCR public data and private data; means for determining the vendor's business name and mailing address from the public data; means for determining the vendor's electronic fund transfer (EFT) information from the private data; and means for using the EFT information to pay the vendor.

In sum, none of the references can render independent claims 1 and 11 unpatentable, and similarly cannot render any of the dependent claims unpatentable.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,



Bao Tran
Reg. No. 37,955